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| EXAMINER |
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PATEL, S

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| ART UNIT | PAPER NUMBER |
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1624

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DATE MAILED: 06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/662,649

Applicant(s)

Zald Jayyosi et al.

Examiner

Sudhaker Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Sep 14, 2000

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-96 is/are pending in the application

4a) Of the above, claim(s) 38-46, 49-52, 60, 67-69, and 71-90 is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-37, 47, 48, 53-59, 61-66, 70, and 91-96 are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

The claims pending in this application are 1, 2-32,33-37,47-48,53-59,61-66,70,91-96.

This application is continuation of international application No. PCT/US00/11833, filed on April; 28, 2000.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein ArI, ArII, Z all are non heterocycle; A/B = 0 or bond.

Group II, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein Ar I = Aryl, ArII = Heterocycle; Z = Heterocycle; A/B = 0 or bond.

Group III, claim(s)(in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein Ar I = Heterocycle, Ar II = Phenyl or non-heterocycle; Z = Heterocycle; A/B = 0 or bond.

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Group IV, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein Ar I = Heterocycle, Ar II = Heterocycle; Z = Non-heterocycle; A/B = 0 or bond.

Group V, claim(s), drawn to Ar I = Heterocycle, Ar II = Phenyl; Z = -C00R21 or -C-0-R21; A/B = 0 or bond.

Group VI, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein Ar I = Heterocycle, Ar II = Phenyl; Z = -C0N(R21)2 or -C0NHS02R21; A/B = 0 or bond.

Group VII, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96 drawn to compounds, composition, a method of use for generic Formula Ia wherein A = S/S0/S02. If this group is elected further restriction/election will be necessary as it involves many unknowns, and specific & exact values for groups Ar I, Ar II, B, E, Z,, and R1- R8 must be submitted.

Group VIII, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein A = N R13/ NR14 C0-. If this group is elected further restriction/election will be necessary as it involves many unknowns, and specific & exact values for groups Ar I, Ar II, B, E, Z,, and R1- R8 must be submitted.

Group IX, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein A = NR4 C0 NR15-.

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Group X, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein $A = C0$, -C0NR5-.If this group is elected further restriction/election will be necessary as it involves many unknowns, and specific & exact values for groups Ar I, Ar II, B, E, Z,, and R1- R8 must be submitted.

Group XI, claim(s) (in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds, composition, a method of use for generic Formula Ia wherein $A = CR14 = N$ -.If this group is elected further restriction/election will be necessary as it involves many unknowns, and specific & exact values for groups Ar I, Ar II, B, E, Z,, and R1- R8 must be submitted.

Group XII, claim(s)(in part) 1, 2-32,33-37,47-48,53-59,61-66,70,91-96, drawn to compounds not included in above Groups I-XI. If this group is elected further election/restriction will be necessary as there are many unknowns, and specific & exact nature of groups Ar I, Ar II, A, B, E, Z, and R1-R8 must be submitted.

Applicants are required to elect one of the above inventions, and also elect species representing the elected invention in reply to this Office Action.

Applicants are urged to classify the claims pertaining to the elected invention, because claims link with different inventions.

2. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: They represent different structures..

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3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Ar I, AR II, Z to gather with integer a-d, g, h, and variables R1-R8, A, B will provide multiples of compounds with different substituents

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

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Ar I, Ar II, 7 Z are aryl, fused- arylcycloalkenyl/arylcyloalkyl; heteroaryl, fused- arylheterocyclenyl/arylheterocyclyl/heteroarylcyloalkenyl/heteroarylheteroayalenyl etc with A, B simultaneously varying will provide many compounds with different substituents.

The following claim(s) are generic: 1-32, 33-

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Aryl as represented by phenyl or naphthalene, and heteroaryl or heteroarylheterocyclenyl rings e.g. pyridine, furan etc are not patentably distinct.
6. A telephone call was made to Mr. Steven J. Scott on 5/21/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel, D.Sc.Tech. whose telephone number is (703) 308 4709.


The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr.Mukund Shah can be reached at (703) 308 4716.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.

S.p.

May 22, 2001.


Mukund Shah

SUPERVISORY PATENT EXAMINER

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